

### REMARKS

Twenty-six claims were originally filed in the present Application. Claims 11-18 were subsequently withdrawn due to a restriction requirement. Claims 1-10 and 19-26 currently stand rejected. Claims 1 and 5 are amended herein. Reconsideration of the Application in view of the foregoing amendments and following remarks is respectfully requested.

### Examiner's Response To Arguments

In paragraph 4 of the Office Action, the Examiner states that "Applicants' arguments filed 8/2/04 have been fully considered but they are not persuasive." However, in the present Final Office Action, the Examiner nowhere responds or acknowledges Applicants' prior arguments regarding claims 6-7 and 23-24 from pages 11-12 of the Response to Office Action filed by Applicants on July 29, 2004. Applicants arguments regarding claims 6-7 and 23-24 are repeated below for the Examiner's reference. Because of the foregoing omission in the Final Office Action, Applicants request that the Examiner withdraw the finality of the present Office Action, and issue a new Non-Final Office Action that specifically responds to Applicants' arguments regarding claims 6-7 and 23-24, or alternately indicate that claims 6-7 and 23-24 are allowable, so that the Application may issue in a timely manner.

35 U.S.C. § 103

In paragraph 2 of the Office Action, the Examiner rejects claims 1-5, 8-10, 19-22, and 25-26 under 35 U.S.C. § 103 as being unpatentable over Applicants' Admitted Prior Art (hereafter AAPA), in view of Japanese Patent No. 357145345 (hereafter '345') in view of Japanese Patent No. 2001189876 (hereafter '876'). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of independent claim 1, Applicants respond to the Examiner's §103 rejection as if applied to amended independent claim 1 which now recites an "*electronic circuit device coupled to the x-ray shielding layer, said x-ray shielding layer obstructing a line-of sight path to said electronic circuit device from an external x-ray source,*" which are limitations that are not taught or suggested either by the cited references, or by the Examiner's citations

thereto.

With regard to claim 1, the Examiner concedes that AAPA “does not disclose the electronic circuit device coupled to an x-ray shielding layer.”

Applicants concur. In addition, the Examiner further concedes that ‘345 similarly “does not disclose the layers are for x-ray shielding.” Applicants again concur. The Examiner then points to ‘876 to purportedly support the rejection of claim 1 because “[t]he ‘876 reference discloses an x-ray protection circuit.”

Applicants respectfully disagree with the Examiner’s interpretation of the ‘876 reference. The ‘876 reference is limited to disclosing an electronic circuit for handling x-ray radiation, as shown in FIG. 2 of ‘876. Applicants submit that an electronic circuit comprised of active electronic components, as shown in FIG. 2 of ‘876, is in no way analogous or similar to Applicants’ claimed “x-ray shielding layer”. In addition, Applicants submit that the electronic circuit of ‘876 operates to reduce radiation emitting from the high voltage circuit.

In paragraph 4 of the Office Action, the Examiner states that “[t]he layers that would protect a chip, or a circuit are shown in the ‘345 reference.” However, as the Examiner has already conceded, ‘345 “does not disclose the layers are for x-ray shielding.” Therefore, for at least the foregoing reasons, the Applicants submit that claim 1 is not unpatentable under 35 U.S.C. § 103 over the cited combination of references, and that the rejection of claim 1 under 35 U.S.C. § 103 is thus improper.

With regard to independent claim 19, the foregoing arguments made with respect to claim 1 apply equally and are hereby incorporated by reference. For at

least the foregoing reasons, Applicants therefore respectfully request reconsideration and allowance of independent claims 1 and 19 so that these claims may issue in a timely manner.

Regarding the Examiner's rejection of dependent claims 2-5, 8-10, 20-22, and 25-26, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of their respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 2-5, 8-10, 20-22, and 25-26 so that these claims may issue in a timely manner.

Furthermore, with regard to claims 5, the Examiner states that "a modification in size . . . are recognized as being within the level of ordinary skill in the art." In response, Applicants amend claim 5 to recite "wherein the second thickness is greater than the first thickness because said radiation shielding top is designed to attenuate said radiation and said x-ray shielding layer is designed to attenuate said x-rays," which are limitations not disclosed in the cited references.

With regard to claims 20-22 and 25-26, in paragraph 4 of the Final Office Action, the Examiner states that "the limitations in those claims . . . are inherently present in the device of AAPA in view of the '345 and '876 references. In the rejections of claims 20-22, and 25-26, it appears that the Examiner continues to utilize Official Notice without expressly stating so. Applicants

respectfully submit that the limitations of claims 20-22, and 25-26 would not have been obvious to one skilled in the art at the time of the invention.

Applicants therefore again request the Examiner to cite specific references in support of these rejections, and failing to do so, to reconsider and withdraw the rejections of claims 20-22, and 25-26, so that these claims may issue in a timely manner.

Furthermore, the Court of Appeals for the Federal Circuit has held that “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination.” In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Applicants submit that there is no teaching of a combination that would result in Applicants’ invention, and therefore the rejections of claims 20-22, and 25-26 under 35 U.S.C §103 are not proper. Applicants therefore respectfully request the Examiner to cite references in support of the Official Notice, and to also indicate where an explicit teaching to combine the cited reference may be found.

For at least the foregoing reasons, the Applicants submit that claims 1-5, 8-10, 19-22, and 25-26 are not unpatentable under 35 U.S.C. § 103 over AAPA in view of ‘345 and ‘876, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 1-5, 8-10, 19-22, and 25-26 under 35 U.S.C. § 103.

In paragraph 3 of the Office Action, the Examiner rejects claims 6-7 and 23-24 under 35 U.S.C. § 103 as being unpatentable over AAPA, in view of '345 and '876, and further in view of U.S. Patent No. 5,086,443 to Bloch et al. (hereafter Bloch). The Applicants respectfully traverse these rejections for at least the following reasons.

As discussed above, since the Examiner has not responded to Applicants' arguments regarding claims 6-7 and 23-24, Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 6-7 and 23-24, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of their respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 6-7 and 23-24 so that these claims may issue in a timely manner.

Further with regard to claims 6-7 and 23-24, the Examiner concedes that neither AAPA, '345, nor '876 disclose "shield layers comprising high and low Z

materials” as claimed by Applicants. Applicants concur. The Examiner then points to Bloch to purportedly support the foregoing rejections, stating that “Bloch discloses an x-ray mirror comprising high and low Z material.” Applicants respectfully disagree with the Examiner’s interpretation of Bloch.

Applicants submit that the “mirror” disclosed by Bloch is not analogous to the “radiation shielding top” claimed by Applicants at least because their functionality is significantly different. For example, a mirror operates to reflect radiation, while a shield functions to attenuate radiation. Applicants therefore submit that Bloch *teaches away* from Applicants’ invention. A prior art reference which teaches away from the presently claimed invention is “strong evidence of nonobviousness.” In re Hedges, 783 F.2d 1038, 228 U.S.P.Q. 2d 685 (Fed.Cir. 1987).

Also with regard to claims 6-7 and 23-24, the Examiner concludes that “[t]herefore, it would have been obvious to one in the ordinary skill in the art at the time of the invention to make the shielding layers with these materials in order to improve their x-ray shielding function.” Applicants respectfully submit that a *general restatement of the advantages disclosed by the Applicants* deriving from implementation of the present invention cannot act as the required teaching or suggestion to combine cited references for a proper rejection under 35 U.S.C. § 103. Courts have repeatedly held that “it is impermissible . . . simply to engage in *hindsight reconstruction* of the claimed invention, using the Applicants’ structure as a template and selecting elements from references to fill in the gaps.” In re Gorman, 18 USPQ 1885, 1888 (CAFC 1991).

For at least the foregoing reasons, the Applicants submit that claims 6-7 and 23-24 are not unpatentable under 35 U.S.C. § 103 over AAPA in view of '345, '876, and Bloch, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 6-7 and 23-24 under 35 U.S.C. § 103.



### Summary

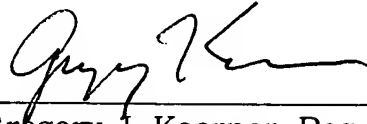
Applicants submit that the foregoing remarks and amendments overcome the Examiner's rejections under 35 U.S.C. §103(a). Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-10 and 19-26 so that the present Application may issue in a timely manner. If there are any questions concerning this amendment, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

Date: \_\_\_\_\_

1/12/05

By: \_\_\_\_\_



Gregory J. Koerner, Reg. No. 38,519  
REDWOOD PATENT LAW  
1291 E. Hillsdale Blvd., Suite 205  
Foster City, CA 94404  
(650) 358-4000